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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
COTTON, ABIGAIL MANDA	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/725,229	SCHONROCK ET AL.	
	Examiner	Art Unit	
	Abigail M. Cotton	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2003 and 23 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 10-20 are pending in the application as of the preliminary amendment received on December 1, 2003.

Priority

Applicant's claim of domestic priority as a divisional of U.S. Patent Application Serial No. 09/243,568, filed February 3, 1999, now abandoned, which claims foreign priority to GERMANY 198 07 774.2, filed February 24, 1998, is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,882,658 to Simon et al, issued March 16, 1999.

Simon et al. teaches a composition to combat photoinduced aging and skin blemishes, comprising at least one saccharide ester of ascorbic acid and at least one saccharide ester of rutin (see abstract, in particular.) Simon et al. teaches that the composition combats against the onset of the photoinduced aging of skin by suppression of the formation of oxygen-containing free radicals, by providing antioxidants (see column 1, line 50, through column 2, line 15, in particular), and thus teaches providing an effective amount of a composition to protect against skin aging caused by oxidation, as recited in claim 10. Simon et al. teaches that the composition is applied to the skin to provide the treatment (see column 5, lines 40-45, in particular.) Simon et al. furthermore exemplifies a skin cream having an ascorbyl compound, namely ascorbyl-2-glycoside, and alpha-glucosyl rutin (see Example 1, in particular.) Accordingly, Simon et al. teaches a method of protecting skin against skin aging caused by oxidation by applying to the skin an effective amount of a composition comprising an ascorbyl compound and alpha-glucosylrutin, as recited in claim 10.

Regarding claims 11-12, Simon et al. exemplifies a composition having alpha-glucosylrutin in an amount of 0.2% by weight (see Example 1, in particular), which meets the limitation of being from 0.01 to 10% by weight as in claim 11, and 0.05 to 5% by weight as in claim 12. Regarding claims 13-14, Simon et al. exemplifies a composition having ascorby-2-glucoside in an amount of 2.0% by weight (see Example

1, in particular), which meets the limitation of being from 0.0001% to 10.0% by weight as in claim 13, and 0.1% to 2.0% by weight as in claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,882,658 to Simon et al.

Simon et al. is applied as discussed for claims 10-14 above, and teaches applying a composition comprising a saccharide ester of ascorbic acid and a saccharide ester of rutin, such as alpha-glucosylrutin, to combat aging of the skin due to oxidation. Simon et al. exemplifies skin compositions having ascorbyl-2-glucoside and alpha-glucosylrutin in the percent by weights recited in claims 11-14 (see Examples 1-3, in particular.)

Simon et al. does provide a specific example of a composition having an ascorbyl compound, alpha-glucosylrutin in the percent by weight recited in claim 11, and a complexing agent, as required by claim 15.

However, Simon et al. does teaches that the compositions comprising the saccharide esters of ascorbic acid and alpha-glucosylrutin can further comprise other adjuvants such as iron-chelating agents (see column 5, lines 1-10, in particular), which is a complexing agent. Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the chelating agent in the ascorbyl compound and alpha-glucosyl rutin composition of Simon, with the expectation of providing a suitable adjuvant for the composition. Thus, claim 15 is obvious over the teachings of Simon et al.

Regarding claim 17, Simon et al. teaches that the chelating agent may be EDTA (see column 5, lines 1-10, in particular), and thus teaches the complexing agent recited in the claim. Regarding claims 18-20, Simon et al. teaches that adjuvants such as the chelating agent can be provided in an amount of from 0.1% to 20 % by weight, which overlaps with the recited weight percentage ranges of from 0.01% to 10.0% by weight as recited in claim 18, 0.05% to 5.0% by weight as recited in claim 19, and 0.1% to 2.0% by weight as recited in claim 20. Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of chelating agent provided in the composition, according to

the guidance provided by Simon et al, to provide a composition having desired antioxidant and/or chelating properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,952,373 to Lanzendorfer et al. issued September 14, 1999.

Lanzendorfer et al. teaches the use of a composition for the treatment of skin (see abstract, in particular.) Lanzendorfer et al. teaches that the composition is capable of treating a number of skin conditions, including photodermatosis (see column 3, lines 38-50, in particular.) Lanzendorfer et al. teaches that a method of treatment involves applying to skin a composition comprising an effective amount of a composition comprising a flavonoid, where the flavonoid can be alpha-glucosylrutin, and an antioxidant (see column 31, line 20, through column 32, line 20, claims 1-4, in particular.) Lanzendorfer et al. teaches that suitable antioxidants for the treatment composition can comprise vitamin C or a vitamin C derivative (ascorbyl compound) (see column 9, lines 5-15, in particular.)

Lanzendorfer et al. does not teach applying a composition that specifically comprises alpha-glucosylrutin and ascorbic acid or an ascorbyl compound, as recited in

claim 10. However, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to combine these components, because Lanzendorfer et al. teaches that the composition comprises a flavonoid, which can be alpha-glucosylrutin, and further comprises an antioxidant, which may be ascorbic acid or an ascorbyl compound. Thus, one of ordinary skill in the art would have found it obvious to apply a composition comprising both alpha-glucosylrutin and ascorbic acid or an ascorbyl compound, with the expectation of providing suitable treatment for a skin disorder, and claim 10 is obvious over the teachings of Lanzendorfer et al.

It is noted that claims 10-20 are directed to a method of protecting skin against skin aging caused by oxidation, by providing an effective amount of a composition comprising alpha-glucosylrutin and ascorbic acid or an ascorbyl compound. However, since the teachings of Lanzendorfer et al. render the claimed composition obvious, the property of such a claimed composition will also be rendered obvious by the prior art teachings, since the properties, namely the enhancement of the mucous membrane compatibility, are inseparable from its composition. Therefore, if the prior art teaches the cosmetic composition or renders the cosmetic composition obvious, then the properties are also taught or rendered obvious by the prior art. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990.) See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not possess or render obvious the same properties as the instantly claimed product. In the instant case, as

Lanzendorfer et al. renders obvious the claimed composition and teaches applying the composition to skin, the property of imparting protection of such skin against aging caused by oxidation is also rendered obvious by Lanzendorfer.

Regarding claims 11-12, Lanzendorfer et al. teaches that the flavonoid such as alpha-glucosylrutin can be present in an amount of from 0.1% to 6% by weight (see column 8, lines 1-1-, in particular), which meets the limitation of being from 0.01% to about 10% by weight as recited in claim 11, and meets the limitation of being from 0.05% to "about" 5% by weight of the composition, as recited in claim 12. Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of alpha-glucosyl rutin provided in the composition, according to the guidance provided by Lanzendorfer et al, to provide a composition having desired skin treatment properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claims 13-14, Lanzendorfer et al. teaches that an antioxidant such as vitamin C and its derivatives can be provided in an amount of from 1-10% by weight (see column 9, lines 38-46, in particular), which meets the limitation of being from 0.001% to 10% by weight as recited in claim 13, and from 0.1% to "about" 2% by weight as recited in claim 14. Furthermore, it is considered that one of ordinary skill in the art

at the time the invention was made would have found it obvious to vary and/or optimize the amount of vitamin C or vitamin C derivative provided in the composition, according to the guidance provided by Lanzendorfer et al, to provide a composition having desired skin treatment properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claims 15-17, Lanzendorfer et al. teaches that the composition can comprise one or more active compound antioxidants (see column 9, lines 38-42, in particular), and that such antioxidants can further include EDTA and citric acid (see column 9, lines 4-8, in particular), which are complexing agents as recited in claims 16-17. Regarding claims 18-20, Lanzendorfer et al. teaches that an antioxidant can be provided in an amount of from 1-10% by weight (see column 9, lines 38-46, in particular), which meets the limitation of being from 0.01% to 10% by weight as recited in claim 18, from 0.05% to "about" 5% by weight as recited in claim 19, and from 0.1% to "about" 2.0% by weight as recited in claim 20. Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of antioxidant provided in the composition, according to the guidance provided by Lanzendorfer et al, to provide a composition having desired skin treatment properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the

optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,882,658 to Simon et al, issued March 16, 1999, as applied to claims 10-15 and 17-20 above, and further in view of U.S. Patent No. 5,952,373 to Lanzendorfer et al. issued September 14, 1999.

Simon et al. is applied as discussed for claims 10-15 and 17-20 above, and teaches applying to skin a composition comprising an ascorbyl compound and alpha-glucosylrutin. Simon et al. further teaches that the composition can comprise other anti-oxidant and/or anti-radical compounds (see column 5, liens 1-10, in particular.)

Simon et al. does not specifically teach that the composition comprises a complexing agent selected form the group recited in claim 16, such as tartaric or citric acid.

Lanzendorfer et al. teaches a applying a composition comprising a flavonoid and an antioxidant to skin (see claims 1-4, in particular.) Lanzendorfer et al. teaches that suitable antioxidants can comprise alpha-hydroxy acids such as citric acid (see column 9, lines 1-5, in particular.)

Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the citric acid antioxidant of Lanzendorfer et al. in the composition of Simon et al. for application to skin, because Simon et al. teaches the desirability of providing an antioxidant in the skin treatment composition, and Lanzendorfer et al. teaches that citric acid is a suitable antioxidant for topical compositions comprising flavonoids such as alpha-glucosylrutin. Thus, one of ordinary skill would have been motivated to provide citric acid in the composition of Simon et al. with the expectation of providing a suitable antioxidant for the composition.

Conclusion

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,145,781 and U.S. Patent No. 5,171,573, both to Suzuki et al, teach the preparation and uses of alpha-glucosyl rutin (see abstract, in particular.) JP 4[1992]-99730 to Hirai et al, and JP 4[1992]-99771 to Inoue et al. teach the prevention of browning of compositions with ascorbic acid (see claims, in particular.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER